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ROBERT E. BUSHNELL*†SARYADVINDER S. SAHOTA†*
JOSEPH G. SEEBER*
MATTHEW J. LESTINA†*
JONG H. PARK‡OF COUNSEL
RICHARD H. STERN*
HENRY M. ZYKORIEMICHAEL D. PARKER
YOUNG JIN KIM, Ph.D.
(REG. PATENT AGENT)† ADMITTED IN MARYLAND
* ADMITTED IN VIRGINIA
‡ ADMITTED IN NEW YORK
◊ ADMITTED IN CONNECTICUT
* NOT ADMITTED IN D.C.**R. E. BUSHNELL**
ATTORNEY AT LAW1522 K STREET, N.W., SUITE 300
WASHINGTON, D.C. 20005-1245
UNITED STATES OF AMERICA

September 19, 2006

INTELLECTUAL PROPERTY LAW

TELEPHONE: (202) 408-9040
FACSIMILE: (202) 289-7100
FACSIMILE: (202) 628-3835

E-MAIL: REBUSHNELL@AOL.COM

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OFFICE OF PETITIONS

Facsimile No.: 571.273.0025

Attn: Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re.: U.S. Patent REISSUE Application For:
REDUCING POWER CONSUMPTION IN
MONITOR BY SWITCHING OFF HEATER
POWER IN POWER-OFF MODE
 Serial No.: 09/942,961
 Inventor: Seung-Cheol HONG
 Original Patent No.: 5,944,830 issued 8/31/99
Our Ref. No.: P54428RE

Dear Sir:

Applicant notes that the Corrected Petition under 37 CFR §§1.59 & 1.181 for Expungement (Paper No. 34) timely filed with the Office on 16th of June 2006 in response to the suggestion by the Supervisory Primary Examiner and the text of the Decision on Petition mailed on 6 June 2006, is neither reflected among the transaction description among the transaction history of this application nor mentioned in any Decisions on Petition.

Specifically, the Decision on Petition mailed on 6 June 2006 indicated that "USPTO stands ready to favorably reconsider a renewed petition that itself merely identifies the location of, but otherwise does not include any improper remark"; Applicant properly responded with the Corrected Petition (Paper No. 34) immediately filed on 16th of June 2006. Today, there has been no decision on that Corrected Petition; instead, Applicant has received a communication from the Examiner asserting that Applicant's "reply filed on 3/30/05 is not fully responsive to the prior Requirement for Information Under 37 C.F.R. §1.105 (Paper No. 20050615)." In essence, Paper No. 20060615 repeats the Requirement for Information in the Information Disclosure Statement filed by Applicant on 27 December 2004 (Paper No. 30) and repeats the same request for information, despite Applicant's fully complete response in accordance with 37 CFR §1.105(a)(vii)(3) and statement that "the information is required to be submitted is unknown and/is not readily available to the party or parties from which it was requested."

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Moreover, Applicant's Corrected Petition was directed to the Office communication (Paper No. 20050323) mailed on 30 March 2005, which stated that the "application has been forwarded to the board of appeals." It would seem that the correct procedure upon grant of Applicant's enclosed Corrected Petition is to return the application to the Art Unit 2112 for forwarding to the Board of Appeals for decision on the outstanding appeal rather than a repetition or verbatim of the Requirement for Information under 37 CFR §1.105 set forth in Paper No. 29 dated 27 October 2004. Furthermore, the braded suggestion in Paper No. 20050615 that Applicant's response in Information Disclosure Statement filed on about 27 December 2004 is bradedly determined to the "not fully responsive to the prior requirement for information under 37 CFR §1.105" contradicts the earlier determination set forth in Paper No. 20050323 that the application "has been forwarded to the board of appeals."

Accordingly, the Office of Petitions is respectfully requested to issue a Decision on Petition granting a relief requested in Applicant's Corrected Petition filed on about 16 June 2006 (Paper No. 34) and return the prosecution history to Art Unit 2112 with instructions to forward the application to the Board of Appeals and Interferences.

Should questions remain unresolved however, the Office of Petition is respectfully requested to telephone Applicant's undersigned attorney.

Respectfully submitted,


Robert E. Bushnell

REB/fw

Enclosure:

1. Copy of Corrected Petition Under 37 CFR §§ 1.59 & 1.181 For Expungement (Paper No. 34) as filed on 6/16/2006;
2. Copy of Response and Information Disclosure Statement (Paper No. 30) as filed on 12/27/2006 in response to Requirement for Information (Paper No. 29) mailed on 10/27/2004.

**CERTIFICATE OF
FACSIMILE TRANSMISSION**

I hereby certify that, on 19 September 2006, this correspondence is being facsimile transmitted to the Office of Petitions, U.S. Patent & Trademark Office (Facsimile No. ~~703-872-9306~~ 571-273-0025)

Total 19 sheets


For Robert E. Bushnell

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of: SEUNG-CHEOL HONG, et al.

JUN 16 2006 OFFICE OF PETITIONS

Original Patent No. 5,944,830 issued on 31 August 1999

OFFICE OF PETITIONS

Serial No.: 09/942,961

Examiner: MYERS, PAUL R

Filed: 31 August 2001

Art Unit: 2112

For: REDUCING POWER CONSUMPTION IN MONITOR BY SWITCHING OFF
HEATER POWER IN POWER-OFF MODE

CORRECTED PETITION UNDER 37 CFR §§ 1.59 & 1.181 FOR EXPUNGEMENTPaper No. 34

Attn: Office of Petitions
Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Facsimile No.: 703.872.9306

Sir:

In response to the Decision on Petition mailed on 6 June 2006, Applicant submits the
Corrected Petition Under 37 CFR §§ 1.59 & 1.181 for Expungement.

After consultation with the Supervisor Primary Examiner, Applicant files this petition to
return the prosecution history of the above-captioned pending U.S. patent application to Art Unit
2112 and for expungement of PTO-90C (Rev.04-03), Paper No. 20050323 mailed on about 30
March 2005, and requests that neither accompanying cover letter nor this petition be made part of
the prosecution history of the above-captioned application, and as reasons therefore, states that:

Folio: P564428RE
Date: 6/16/06
I.D.: REB/fw

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**CERTIFICATE OF
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the Office of Petitions of the U.S. Patent &
Trademark Office.

Total 5 sheets

Robert E. Bushnell
For Robert E. Bushnell
Reg. No. 27,774

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PATENT
P54428RE**STATEMENT OF FACTS**

On about 1 September 2004, the Board of Patent Appeals and Interferences issued Paper No. 28, a *Remand To Examiner* for consideration of specific issues posed by the Board in its *Opinion* for the Examiner's consideration of 37 CFR § 1.105 and possible requests for information.

Subsequently, in Paper No. 29 dated on about 27 October 2004, the Examiner issued a Request under 37 CFR §1.105 for various items of information.

Applicant, in response to Paper No. 29, filed a *Response*, Paper No. 30, on about 27 December 2004 replying to the Examiner's request for information under 37 CFR §1.105, providing twelve (12) English language references, in an Information Disclosure Statement conforming with 37 CFR §1.56, §1.97 and §1.98 as amended, a PTO-1449 listing those twelve references, and a Request for Written Clarification in accordance with 37 CFR §1.104, of whether the Examiner's Request for Information was specific to either the parent application Serial No. 09/814,502 which was issued as U.S. Patent No. 5,944,803 on 31 August 1999, or the above-captioned reissue patent application Serial No. 09/942,981 filed on 31 August 2001.

Subsequently, on about 30 March 2005, the Examiner issued Paper No. 20050323, which contained a unclear and improper statement in the third sentence.

The Examiner was unable to explain this statement due to his absence from the office for personal leave, and Applicant's assigned attorney spoke with the Supervisory Primary Examiner. It was agreed that the application should be returned to the Art Unit 2112 for expungement of Paper No. 20050323 for reasons of attributable among others, to the issues raised under 37 CFR §1.4, and for consideration of the questions posed by the Board in its *Remand To Examiner* (Paper No. 28).

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06/16/2006 FRI 19:39 [TX/RX NO 5515] 002

09/19/2006 TUE 18:47 [TX/RX NO 5914] 004

PATENT
P54428RE**REMARKS**

The Decision on Petition mailed on 6 June 2006 stated that:

"The US PTO stands ready to favorably reconsider a renewed petition that itself merely identifies the location of, but otherwise does not include, any improper remark, and will thereafter expunge, or more properly in, as here, an IFW file, close the initial examiner's communication and the instant petition."

In this Corrected Petition, Applicant has avoided the repetition of the improper remark of the third sentence used by the Examiner in Paper No. 20050323.

No fee is incurred by filing this Corrected Petition.

It is unclear from the statement of the Examiner set forth in Paper No. 20050323 precisely what the Examiner has either considered or determined in view of the specific issues of posed by the Board in its *Remand To Examiner* and by the prior art references provided by Applicant in Applicant's response of 27 December 2004.

It should not be a matter of a surprise that the claims presented in Applicant's U.S. Patent No. 5,944,803 issued on 31 August 1999 are directed to subject matter that could be viewed as different in nature, scope or content from the claims presented in any reissue application. The difference in scope, content and direction arises from the fact that different considerations are before the Applicant at the time of drafting of the claims in the issued patent than at the time of drafting of claims for the reissue application. Consequently, the inventors, or alternatively, the attorney representing the inventors, are focused upon different considerations. Even assuming arguendo that any U.S. patent discloses but a single invention, the principles of that invention may be represented

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P54428RE

differently by claims appearing in the issued patent from the claims presented in the reissue application. It is unclear why the Examiner has labeled this observation by using improper wording of the third sentence in Paper No. 20050323; moreover, the Examiner's statement is unnecessary, and prejudices both the presumption of validity and quality of examination. This style of examination is not helpful to Applicants.


The information which Applicant request to be expunged does not fall within the information forming part of the disclosure as specified in the §1.59(a)(2) and it is necessary to remove the taint placed upon this application by the Examiner's suggestion that Applicant's observations constitute a "disingenuous statement." Accordingly, Remand of the Prosecution History to the Group Art Unit and expungement of Paper No. 20050323, Form PTO-90C is appropriate under 37 CFR §1.59.

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P54428RE**RELIEF REQUESTED**

Commissioner is therefore respectfully requested to:

- A. Return the prosecution history from the Board of Patent Appeals and Interferences to Art Unit 2112;
- B. Re-open examination of the application on the merits;
- C. Expunge Paper No. 20050323, Form PTO-90C dated on about 30 March 2005;
- D. Request the Examiner to comply with the request set forth in the *Remand To Examiner* by the Board of Patent Appeals and Interferences; and
- E. Grant such other and further relief as justice may required.

Respectfully submitted,


Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

Suite 300, 1522 "K" Street, N.W.
Washington, D.C. 20005
(202) 408-9040

Folio: P54428RE
Date: 6/16/06
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06/18/2006 FRI 19:39 [TX/RX NO 5515] 005

09/19/2006 TUE 18:47 [TX/RX NO 5914] 007